

## REMARKS

The Office Communication mailed November 10, 2005 has been received and reviewed. The application is subject to a restriction requirement. The embodiments disclosed are divided as follows: Species 1 includes Figures 1 through 7, Species 2 includes Figure 8, Species 3 includes Figure 9, and Species 4 includes Figures 10 and 11.

Applicants elect Species 1 and traverse the restriction requirement with respect to the remaining Species 1 through 4 for the reasons stated below. Claims 1 through 28 all require a shingle having a backing as illustrated in Figures 1 through 7 and therefore belong to the elected species.

### DESIGNATED SPECIES ARE NOT INDEPENDENT AND DISTINCT

Applicants assert that although the designated species may be patentably distinct, they are neither independent nor distinct as required for restriction. Restriction is allowed only if two or more inventions "are able to support separate patents and they are either independent or distinct." MPEP 803.

In order for inventions to be independent there must be "no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect." MPEP 802.01. Distinct inventions are those that are "not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is patentable (novel and nonobvious) over the other (though they may each be unpatentable over the prior art)." MPEP 802.01

Applicants assert that these requirements are not met inasmuch as the designated species are all related in design, operation, and effect. The designated species are all related as embodiments of a novel shingle panel. Figures 1 through 9 each illustrate shingles 20, a backing piece 30 for securing to the shingles 20, or both. Figures 10 and 11 illustrate intermediate products formed in the process of making the shingle panels of Figures 1 through 9. All embodiments are therefore connected in design inasmuch as they all relate to apparatus for

mounting shingle panels attached to a backing piece. All embodiments are connected in operation inasmuch as they are all designed to operate as shingles. The effect of all embodiments is to provide a covering for walls and roofs.

#### EXAMINING DESIGNATED SPECIES DOES NOT CREATE UNDUE BURDEN

Applicants further assert that restriction is improper because the designated species do not create a serious burden with regards to field of search. Restriction of independent and distinct inventions is not proper “if the search and examination of all the claims in an application can be made without serious burden;” rather, “the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” MPEP 803.

A prima facie showing of a serious burden “may be shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP §808.02.” MPEP 803. Applicants assert that the examiner has not indicated the presence of any of these or any analogous factors in making the restriction requirement. All of the designated species belong to the same USPTO classes and subclasses. For example, Class D25, subclass 139 lists only shingles. All of the designated species also belong to Class 52, subclass 518, which includes “lapped multiplanar surfacing; e.g. shingle type.” Accordingly, the burden of establishing a prima facie case of a serious burden has not been met.

#### A GENERIC LINKING CLAIM IS ALLOWABLE

The designated species are not subject to a restriction inasmuch as there is an allowable claim generic to the species. MPEP 806.04 (“A reasonable number of species may be claimed when there is an allowable claim generic thereto.”). A generic claim is one requiring “no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim.” MPEP 806.04(d).

Independent claims 9, 17, and 27 each recite all of the elements of claim 1, which is therefore generic. The shingle of claim 1 has a first edge, a second edge, a third edge and a fourth edge, wherein the first edge is substantially opposite the second edge and the third edge is

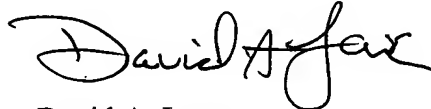
substantially opposite the fourth edge. The backing of claim 1 secures to the shingle and has a first edge, a second edge, a third edge and a fourth edge, wherein the first edge is substantially opposite the second edge and the third edge is substantially opposite the fourth edge. The first edge of the backing is substantially aligned with the first edge of the shingle, the second edge of the backing is offset the second edge of the shingle, the third edge of the backing is offset the third edge of the shingle, and the fourth edge of the backing is offset the fourth edge of the shingle.

#### CONCLUSION

In making the above arguments, Applicants do not admit that any of the independent claims or illustrated embodiments is obvious in light of one another. In view of the foregoing remarks, Applicants respectfully submit that the restriction requirement be withdrawn and all pending claims be examined.

Respectfully submitted,

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